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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/460,965

12/14/1999

NING XUE

99-222

3179

24319 7590 06/16/2004

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MILPITAS, CA 95035

EXAMINER

WERNER, BRIAN P

ART UNIT

PAPER NUMBER

2621

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Attachment to Advisory Action  
Paper No. 9**

1. Examiner agrees with applicant's remarks at response page 2, pertaining to inventorship and the 112 rejections. The 112 rejection is withdrawn. However, the only support for the claimed subject matter can be found in the abstract. This subject matter should be added to the detailed description in the appropriate place per 37 CFR 1.75(d)(1); without adding new matter.

2. The Examiner disagrees with the applicant's remarks at response pages 3-4. These arguments are not convincing regarding conception of the invention prior art February 1, 1999. First, at response page 2, applicant refers to a "drawing, found in a notebook" at the "first page of exhibit A of declaration". There is no drawing at exhibit A, first page. Second, and to reiterate:

The relationship between the four (4) separate documents that comprise Exhibit A is unclear, the dates of each of the documents is unclear, the applicant does not describe the relevance of each of the documents, and the documents either individually or collectively do not appear to describe all of the claim limitations.

MPEP 715.07 states that "conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc ... [and] conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also." In the case of Exhibit A,

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it is unclear which one of the four (4) separate documents therein proves comprehension of "the means themselves and their interaction".

MPEP 715.07 further states, "each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show." This is clearly not the case as described above. Exhibit A comprise four (4) separate documents, none of which are "specifically referred to in the ... declaration", especially "in terms of what it is relied upon to show."

MPEP 715.07 further states, "the affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date." The applicant's affidavit does not clearly explain which facts he is relying upon to show completion.

MPEP 715.07 further states, "vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts ..." The applicant's declaration and Exhibit A are tantamount to general assertions and broad statements.

MPEP 715.07 further states that "applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant." The applicant has not done this, as described above.

The documents provided as part of the previously submitted exhibit A are not convincing as "proof" that the "means themselves and their interaction" were "comprehended" prior to February 1, 1999. Further, each exhibit relied upon IS NOT

**Advisory Action**

Application No.

09/460,965

Applicant(s)

XUE, NING

Examiner

Brian P. Werner

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☒ Applicant's reply has overcome the following rejection(s): See Attachment.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-20.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

**BRIAN WERNER**  
**PRIMARY EXAMINER**

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specifically referred to in the affidavit or declaration "in terms of what it is relied upon to show." Further, the affidavit or declaration DOES NOT "clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date." Further, applicant's "vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice amounts essentially to mere pleading, unsupported by proof or a showing of facts ..." Further, "a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant" has not been provided.

Brian Werner  
Primary Examiner  
Art Unit 2621  
Office: 703-306-3037



**BRIAN WERNER**  
**PRIMARY EXAMINER**